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DEC 8 1999

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In re Application of
QUIBELL, et al.
U.S. Application No.: 09/171,671
PCT No.: PCT/GB97/01158
International Filing Date: 24 April 1997
Priority Date: 24 April 1996
Attorney's Docket No.: 179-28
For: AUTO-DECONVOLUTING
COMBINATORIAL LIBRARIES

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This decision is issued in response to applicants Petition under 37 CFR 1.47(a), filed on 19 April 1999. Applicants have paid the petition fee under 37 CFR 1.17(i).

BACKGROUND

On 24 April 1997, applicants filed international application PCT/GB97/01158 which claimed a priority date of 24 April 1996 and which designated the United States.

On 21 November 1997, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e., 26 October 1998 (24 October 1998 was a Saturday).

On 23 October 1998, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by: (1) a copy of the international application; (2) a first preliminary amendment; and (3) a check in the amount of \$1060 (\$930

On 18 March 1999, the United States Designated Elected Office (DO EO US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form

PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required. The Notification also informed applicants that the failure to submit the declaration within one month of the date of the Notification or within 31 months of the priority date, whichever was later, would result in abandonment of the application.

On 19 April 1999, applicants filed the Petition under 37 CFR 1.47(a). The Petition claims that one of the inventors, Dr. Terance Hart, refused to execute the declaration of inventors, and it requests that the application be permitted to continue without Dr. Hart's signature. The Petition was accompanied by the following: (1) a Declaration of Dr. Antony J. Caston setting forth the attempts made to obtain Dr. Hart's signature; (2) a declaration of inventors which lists Dr. Hart as an inventor and which is executed by both the other inventors; (3) a \$130 check for the petition fee; and (4) an executed Small-Entity Declaration.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants have submitted a payment of \$130 as the petition fee; thus, item (1) is satisfied. In addition, page two of the Petition sets forth the last known address of the non-signing inventor, Dr. Hart. Item (2) is therefore satisfied as well.

With respect to item (3), applicants have submitted a declaration which is executed by the two of the three inventors and which contains an unsigned signing block for Dr. Hart. Section 409.03(a), page 400-24 of the Manual of Patent Examining Procedure states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Thus, the declaration of inventors here can be treated as having been signed by the inventors

As for item (4), the factual proof required to demonstrate a refusal to execute the application documents is set forth in section 409.03(d), pages 400-25 thru 26 of the Manual of Patent Examining Procedure, which states, in part (emphasis added):

Before a refusal can be alleged, **it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.** A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Here, applicants have not shown that they forwarded to Dr. Hart "a copy of the application papers (specification, including claims, drawings, and oath or declaration)" for his signature. Rather, it appears that they only forwarded to Dr. Hart "assignment and power of attorney documents" for a number of patent applications, including the instant application. As set forth above, a refusal cannot be alleged until after a copy of the full application has been forwarded to he nonsigning. Applicants have therefore failed to satisfy item (4) of the requirements for a grantable petition under 37 CFR 1.47(a). Accordingly, the Petition must be dismissed.


CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



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